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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/088,493 | 03/27/2002 | Robert Stephen Mules | 053694-0113 | 9733 |

22428 7590 08/14/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

SAVAGE, MATTHEW O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1723

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/088,493 | MULES, ROBERT STEPHEN | |
| | Examiner | Art Unit | |
| | Matthew O Savage | 1723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3-27-03</u> . | 6) <input type="checkbox"/> Other: _____ |

The disclosure is objected to because of the following informalities:

On line 13 of page 4 of specification, "8" should be changed to -11--;

On line 14 of page 4 of the specification, "11" should be changed to -7--;

On line 19 of page 4 of the specification, "cap 3" should be changed to -cap 4--.

Appropriate correction is required.

The drawings are objected to because:

With respect to FIG. 1, reference number "31" referring to the "overhanging annular lip" should be changed to -35--.. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieden et al.

With respect to claim 1, Brieden et al disclose a housing 1 (see FIG. 1) having an inlet and outlet, a filter element 14 mounted on a support 3 within the housing between the fluid inlet and fluid outlet, the housing having a drain outlet 11 closed by the filter element support and a resilient loading element 17 (see FIG. 2) loading the support against the drain outlet.

With respect to claim 3, Brieden et al disclose the housing as including a base 1 and a removable cap 2 fitted together, the drain outlet 11 being formed in the base.

Concerning claim 4, Brieden et al disclose the loading element 17 as being provided between the support 3 and cap 2.

As to claim 5, Brieden et al disclose the support as being retained on the removable cap (e.g., via parts 4).

Regarding claim 6, Brieden et al disclose the support as having a retaining portion 4 protruding from the support and engaging the cap, and the loading element as being a coiled spring 17, the coils encircling the retaining portion (e.g., encircling an inner periphery of the retaining portion).

Concerning claim 11, Brieden et al disclose the fluid outlet as being disposed adjacent the drain outlet 11 and having a rim (e.g., defined by part 16) protruding into the housing beyond the drain outlet.

Claims 1, 3-7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Neufeld et al.

With respect to claim 1, Neufeld et al disclose a housing 22 (see FIG. 5) having an inlet and outlet, a filter element 26 mounted on a support 28, 94, 74 within the housing between the fluid inlet and fluid outlet, the housing having a drain outlet 66 closed by the filter element support and a resilient loading element 30 loading the support against the drain outlet.

With respect to claim 3, Neufeld et al disclose the housing as including a base 36 and a removable cap 24 fitted together, the drain outlet 66 being formed in the base.

Concerning claim 4, Neufeld et al disclose the loading element 30 as being provided between the support and cap 24.

As to claim 5, Neufeld et al disclose the support as being retained on the removable cap (e.g., via parts 54, 84).

Regarding claim 6, Neufeld et al disclose the support as having a retaining portion 54 protruding from the support and engaging the cap, and the loading element as being a coiled spring 30, the coils encircling the retaining portion (e.g., encircling an outer periphery of the retaining portion).

As to claim 7, Neufeld et al disclose the filter element 26 as being annular and the support as including an annular end wall 94 extending around one end of the filter element, the annular end wall closing the drain outlet (e.g., via part 74) and the loading element loading the support axially.

Concerning claim 11, Neufeld et al disclose the fluid outlet as being disposed adjacent the drain outlet 11 and having a rim 44 protruding into the housing beyond the drain outlet.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann in view of Neufeld et al.

With respect to claim 1, Baumann discloses a housing 10 (see FIG. 1) having an inlet and outlet, a filter element 22 mounted on a support 34 (e.g., the lower end cap) within the housing between the fluid inlet and fluid outlet, the housing having a drain outlet 28 closed by the filter element support. Baumann fails to specify the resilient support. Neufeld et al disclose an analogous filter including a resilient loading element 30 for loading a support against a drain outlet 66 and suggests that such an arrangement increases the tolerances in axial length of the filter element (see lines 59-61 of col. 4) while permitting re-use of a filter housing cover. It would have been obvious to have modified the filter of Baumann so as to have included the resilient loading element and associated structure in order to increase the tolerances in axial length of the filter element while permitting re-use of the cover.

Concerning claim 2, Neufeld et al disclose the loading element as axially loading a support, and Baumann discloses a support having axially loaded sealing faces 30 which seal the filter element between the inlet and outlet.

With respect to claim 3, Baumann disclose the housing as including a base 10, 12 and a removable cap 18 fitted together, the drain outlet 28 being formed in the base.

Concerning claim 4, Neufeld et al disclose the loading element 30 as being provided between the support and cap 24.

As to claim 5, Neufeld et al disclose the support as being retained on the removable cap (e.g., via parts 54, 84).

Regarding claim 6, Neufeld et al disclose the support as having a retaining portion 54 protruding from the support and engaging the cap, and the loading element as being a coiled spring 30, the coils encircling the retaining portion (e.g., encircling an outer periphery of the retaining portion).

As to claim 7, Baumann discloses the filter element 22 as being annular and the support as including an annular end wall (see FIG. 1) extending around one end of the filter element, the annular end wall closing the drain outlet (e.g., via part 30) and the loading element loading the support axially.

As to claim 8, Baumann discloses the support as having a resilient annular valve element 30, 32 which constitutes a non-return valve across the fluid inlet and which seals the drain outlet.

Concerning claim 9, Baumann discloses the annular valve member as having a base portion 30 adjacent the annular end wall of the support, the base portion sealing the drain outlet 28, and a flexible flap 32 extending from the base portion to close the inlet and constitute the non-return valve.

Regarding claim 10, Baumann discloses the valve element as being retained on the annular end wall of the support (e.g., via part 34).

Concerning claim 11, Neufeld et al disclose the fluid outlet as being disposed adjacent the drain outlet 11 and having a rim 44 protruding into the housing beyond the drain outlet.

The prior art fails to teach or suggest filter assembly including the circular wall 26 and widened portion bounding the drain outlet 31 which seals against the lower annular surface of the resilient valve element 28 as shown in FIG. 1 of the drawing Figures. Accordingly, instant claim 1 would be allowable if amended to include the limitations of instant claims 7, and 8 as well as the novel limitations specified.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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M. Savage
Matthew O Savage
Primary Examiner
Art Unit 1723

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13 August 2003